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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/967,303

Filing Date: September 27, 2001

Appellant(s): DUNLAP ET AL.

Walter Karnstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/18/2007 appealing from the Office action mailed 12/15/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Patents

Fang (US 6,628,311)

Publications/Screen captures

Microsoft Word ("MS Word") Screen Dumps, pages 1-5 (1999) version.

Official Notice

Copiers, fax machines, digital senders, and multifunctional peripherals are all forms of image capture/creation devices and are all well known auxiliary devices.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8, 14-15, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word ("MS Word," see screen shots pages 1-5).

As per independent claim 1, the MS Word "What's This" tool teaches a method for accessing instructions on a device having a user interface, the method comprising the steps of: receiving a user-selection of a first help mode displayed on the user interface (page 1, figure 2), the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function (page 2, figure 3); upon receiving a user-selection of the icon, displaying a help window including an identification of a function associated with the icon (page 2, figure 3). The MS Word "What's This" tool does not disclose a link to instructions related to accomplishing the function; and in response to user-selection of the link, displaying the instructions related to accomplishing the function.

The MS Word Help tool teaches a link to instructions related to accomplishing the function (page 4, figure 7); and in response to user-selection of the link, displaying the instructions related to accomplishing the function (pages 4-5, figures 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of the MS Word "What's This" tool to include a link to instruction related to a function and in response to user selection of the link displaying the instructions, as taught by the MS Word Help tool, with the motivation to reduce the number of steps required to access help information.

Claims 6, 14, and 21 are similar in scope to claim 1, and are therefore rejected under similar rationale.

As per claim 2, which is dependent on claim 1, the MS Word "What's This" tool teaches returning to the first help mode on the user interface after displaying the

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instructions, receiving a next selection of a different icon displaying a different help window including an identification of a next function associated with the different icon (page 2, figure 4). The MS Word "What's This" tool does not disclose a next link to instructions related to accomplishing the next function; and in response to user-selection of the next link, displaying instructions related to accomplishing the next function.

The MS Word Help tool teaches a next link to instructions related to accomplishing the next function (page 4, figure 7); and in response to user-selection of the next link, displaying instructions related to accomplishing the next function (pages 4-5, figures 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of the MS Word "What's This" tool to include a link to instruction related to a function and in response to user selection of the link displaying the instructions, as taught by the MS Word Help tool, with the motivation to reduce the number of steps required to access help information.

Claim 22 is similar in scope to claim 2, and is therefore rejected under similar rationale.

As per claim 3, which is dependent on claim 1, the MS Word "What's This" tool teaches that the identification of a function associated with the icon includes a description of the function (page 2, figures 3-4).

As per claim 4, which is dependent on claim 1, the MS Word Help tool teaches that the instructions related to accomplishing the function include a series of steps a

user executes to accomplish a task associated with the function (pages 4-5, figures 7-9).

As per claim 5, which is dependent on claim 1, MS Word teaches receiving a user-selection of a second help mode displayed on the interface (page 2, figure 5), the second help mode presenting a user with a list of help topics; receiving a user-selection for a help topic from the list; and displaying instructions for accomplishing a function related to the user-selected help topic (page 3, figure 6).

Claims 7, 15, and 23 are similar in scope to claim 5, and are therefore rejected under similar rationale.

As per claim 8, which is dependent on claim 7, the teachings of MS Word in regards to claim 7 have been discussed above. MS Word does not disclose that the user interface includes a touch screen, which accommodates user-selection of the help menu and subsequently user-selection of either of the first help mode and the second help mode. Official Notice is given that the use of a touch screen is notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of MS Word to include a touch screen input means with the motivation to provide an intuitive interface that allows the user to use their finger to make selections.

Claims 9-13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word ("MS Word," see screen shots pages 1-5) in further view of Fang (US006628311B1).

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As per claims 9-13, which are dependent on claim 8, the teachings of MS Word in regards to claim 8 have been discussed above. MS Word does not disclose the type of devices that can be used with this help system. Fang teaches that the device running a help system is an auxiliary device (column 1, lines 17-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of MS Word to include running a help system on a plurality of auxiliary devices, as taught by Fang, with the motivation to provide help on a plurality of devices that require user interaction.

Fang explicitly teaches that the auxiliary device may be a printer or a scanner (i.e. a image capture/creation device). However, he does not expressly disclose that the auxiliary device is a copier, a fax machine, a digital sender, or a multifunction peripheral. Official Notice is given that copiers, fax machines, digital senders, and multifunction peripherals are all forms of image capture/creation devices and are all well known auxiliary devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a copier, a fax machine, a digital sender, or a multifunction peripheral in the list of auxiliary devices taught by Fang with the motivation that all of these devices support image capture and creation.

Claims 16-20 are similar in scope to claims 9-13, respectively, and are therefore rejected under similar rationale.

(10) Response to Argument

The Appellant argues:

- a. The MS Word Screen Dumps do no clearly disclose a method for accessing information that includes a first help mode that allows a user to chose an icon for identification of a function associated with the icon without invoking the function.
- b. The MS Word Screen Dumps do no disclose a method for accessing information that includes displaying instructions related to accomplishing the function associated with an icon identifiable with the first help mode.
- c. The MS Word Screen Dumps do no teach or suggest modifying the MS Word "What's This?" tool to include a link to instructions related to accomplishing the function of an icon identifiable with the "What's This?" tool.
- d. The Examiner has proposed a modification that changes the principle of operation of the "MS Word Help" tool.
- e. Fang does not disclose an auxiliary device that runs a help system.
- f. There is no motivation to combine Fang with the MS Word Help tools.
- g. Combining the MS Word Help Tools with the GUI disclosed in Fang would change the principle of operation of the GUI.
- h. Combining the Fang help system with the MS Word would render MS Word unsatisfactory for its intended purpose.

In regards to argument (a), the Examiner disagrees. The Examiner concedes that the scanned images of the screen shots are not the best quality; however it is still

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clear that Figure 4 shows that the Bold button was not activated by using the "What's This?" tool; therefore the icon's functions is indeed disabled after pressing the "What's This?" tool. Figure 4 shows an inactivated bold button, right above the cursor. If the button were activated, then it would have a distinct shading and border around it. If the applicant were to look three buttons to the right of the bold button, they would clearly see an "align left" button that is indeed activated. This is how an activated button is presented in Microsoft Word. For further evidence the Examiner includes with this brief supplemental evidence, Figures 1-5, which illustrate zoomed in screenshots of the bold button (before and after the "What's This?" cursor has been used on it). It is evident in the screen shots that when the "What's This?" cursor hovers over the icon for some time that a tool tip (i.e. a short description) is displayed on the screen (i.e. Figure 2). But when the user clicks on the bold button using the "What's This?" cursor, then a longer more detailed help description is shown (i.e. Figure 3).

In regards to argument (b), the Examiner disagrees. The MS Word Screen Dumps show one example of instructions that are related to buttons on the toolbar. The Microsoft Word help is an all inclusive help tool. It contains help for every icon in Microsoft Word. For further evidence the Examiner includes with this brief supplemental evidence, Figure 6, which illustrates instructions on how to use the bold feature in Microsoft Word.

In regards to argument (c), the Examiner disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion,

or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) (Emphasis added). In this case, the motivation to reduce the number of steps required to access help information is knowledge generally available to one of ordinary skill in the art. The Applicant attempts to rebut this argument by stating that Microsoft Word help requires many steps (page 15) and therefore those skilled in the art (the software engineers of MS Word) were not motivated in reducing the number of steps to access help information. However, the Applicant made an incorrect assumption that the Examiner was combining all of MS Word Help with the "What's This?" tool. The only aspect of Microsoft Word Help that the Examiner used in the combination were the links within the help files (i.e. Figure 7 and 8). It is clear that those links are there for the user's benefit because the user will not have to type in information to search if they have further questions. They can simply click on the links and more information will be provided to them regarding the topic they had clicked on. The use of links within help files is clearly a benefit to the user, because it reduces the number of steps in accessing help, and therefore there is a clear motivation to combine the references.

In regards to argument (d), the Examiner disagrees. The Applicant states that the "The Examiner proposes modifying the 'MS Word Help' tool to have it automatically access a predetermined help topic". The Applicant is incorrect; the functionality of automatically accessing a predetermined help topic already exists in "MS Word Help".

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When a user clicks on a link within that Microsoft Word Help new information about that specific (i.e. predetermined) topic is presented to the user (i.e. Figures 7-9). Therefore; the Examiner is not changing the principle of operation of the "MS Word Help" tool but simply combining some of the functionality of "MS Word Help" tool with the "What's This?" tool.

In regards to argument (e), the Examiner disagrees. The Examiner concurs that the GUI for the auxiliary devices in Fang is separate from the device. However, Applicant's claims do not recite that the GUI is a physical part of the device separate from the computer. The claims merely recite, "A device ... comprising ... a user interface...". A graphical user interface does not have to be local. An interface can be something running on a computer that allows the computer to interact with the specific auxiliary device. The Applicant argues that, "a user may interface with the device through the device's user interface, and without the use of a computer configured with the necessary device driver" (Pages 32 and 33). This limitation is not claimed, so it can not be given any weight.

In regards to argument (f), the Examiner disagrees. The Applicant states, "neither the MS Word Screen Dumps nor Fang disclose running help systems on a plurality of auxiliary devices"(Page 33). The Applicant therefore concludes that the Examiner must have used the motivation from the Applicant's disclosure. The Examiner holds that the Applicant does not clearly claim running help systems on a plurality of auxiliary devices, but simply having a user interface that is operable with the device. The user interface does not have to be on the device itself.

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In regards to argument (g), the Examiner disagrees. The Fang reference is only being relied upon to teach that help systems exist for auxiliary devices. The addition of the Fang reference to MS Word references would lead to a combination that would be beneficial to the user because it would result in help systems that are more descriptive and user friendly.

In regards to argument (h), the Examiner disagrees. The Applicant incorrectly states that, "Interdependencies [in MS Word] do not exist between different icons, such that by activating a first icon a second icon may be deactivated" (Page 42). One example of interdependencies between the icons in MS Word is the "Align Left, Center, Align Right, and Justify" icons (Supplemental Evidence, Figure 7 and 8). Only one of the icons can be active at one time. If one icon that is not currently active is activated, then the one that was active become inactive. Furthermore, the addition of the Fang reference to MS Word references would lead to a combination that would be beneficial to the user because it would result in help systems for auxiliary devices that are more descriptive and user friendly.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Boris Pesin 

May 04, 2007

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Supplemental evidence

Figure 1

The Bold button as it normally is.

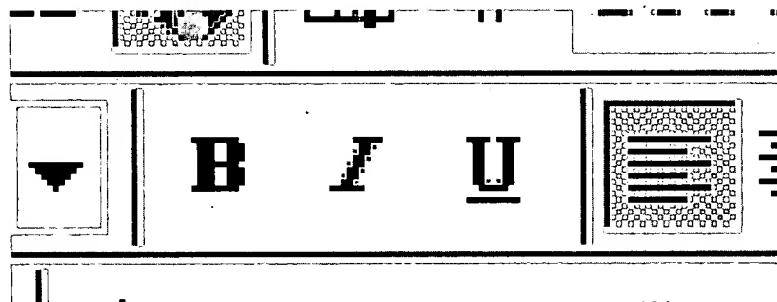


Figure 2

The Bold button when the "What's This?" cursor is hovering over the button and nothing has been pressed.

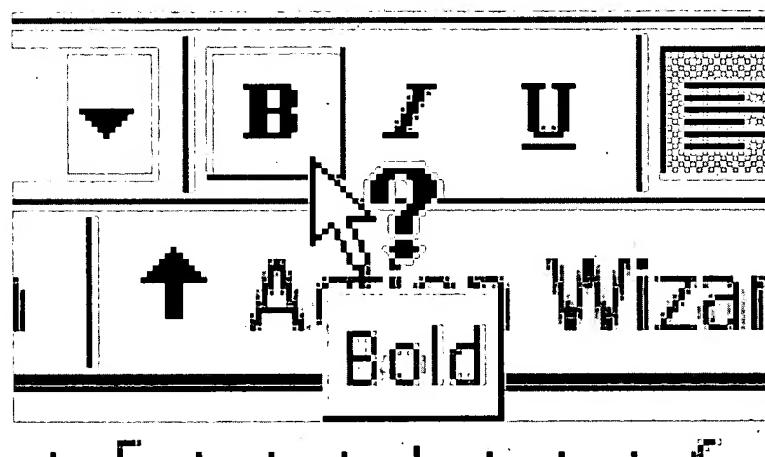


Figure 3

Information about the Bold button after the “What’s This?” tool was used to click on the Bold Button. This figure clearly shows that the bold button has not been activated by using the “What’s This?” tool. If it were activated it would look like figure 5.

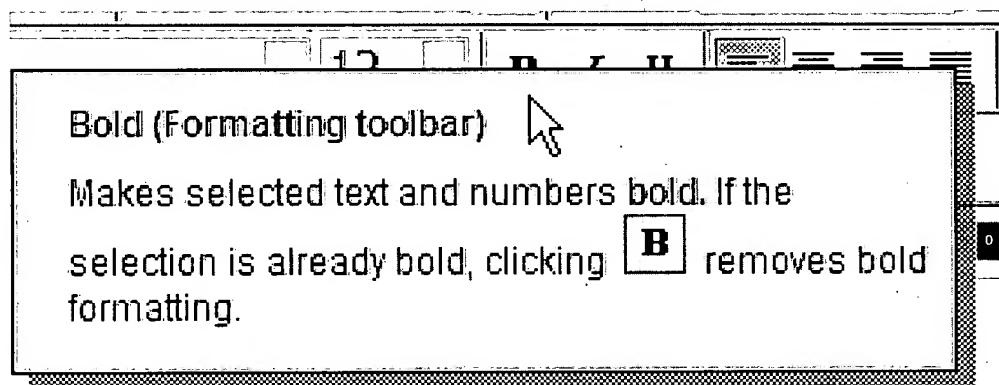


Figure 4

Illustrates an activated bold button. Microsoft Word clearly distinguished between an activated button and an inactive one by emulating a depressed state and showing a different shade and border for the active button.

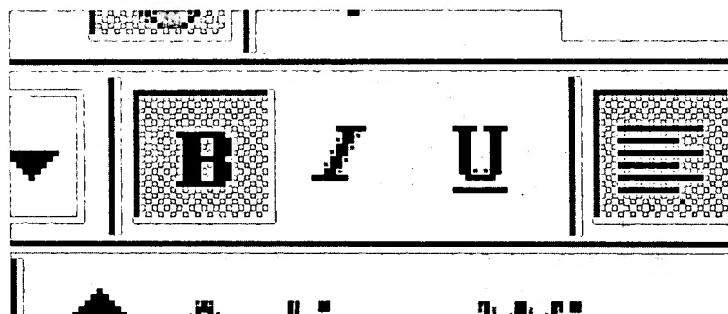


Figure 5

This screen shot was taken after the bold button was activated and then the "What's This?" tool was used on the button. Once again the button was not affected, because if it were the button would go back to the normal state (i.e. Figure 1).

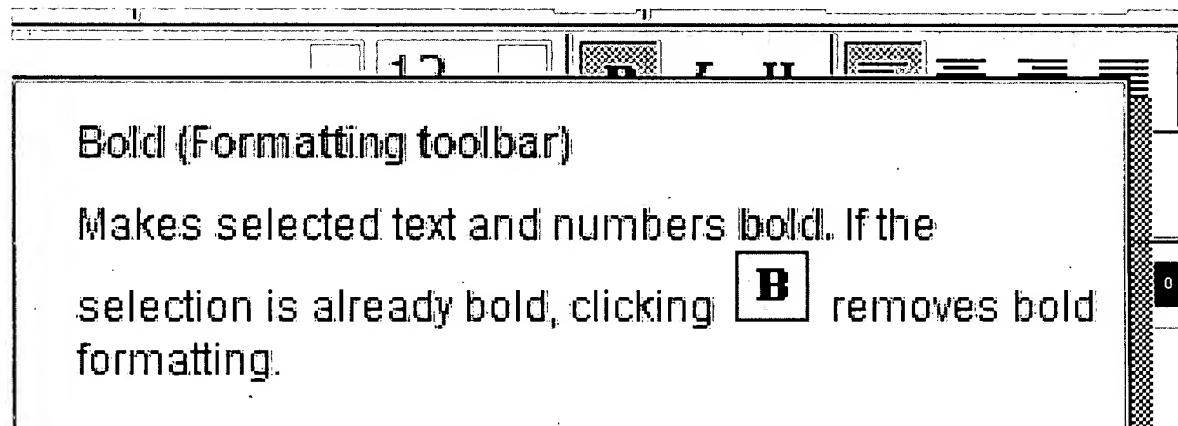


Figure 6

Instruction on how to bold text.

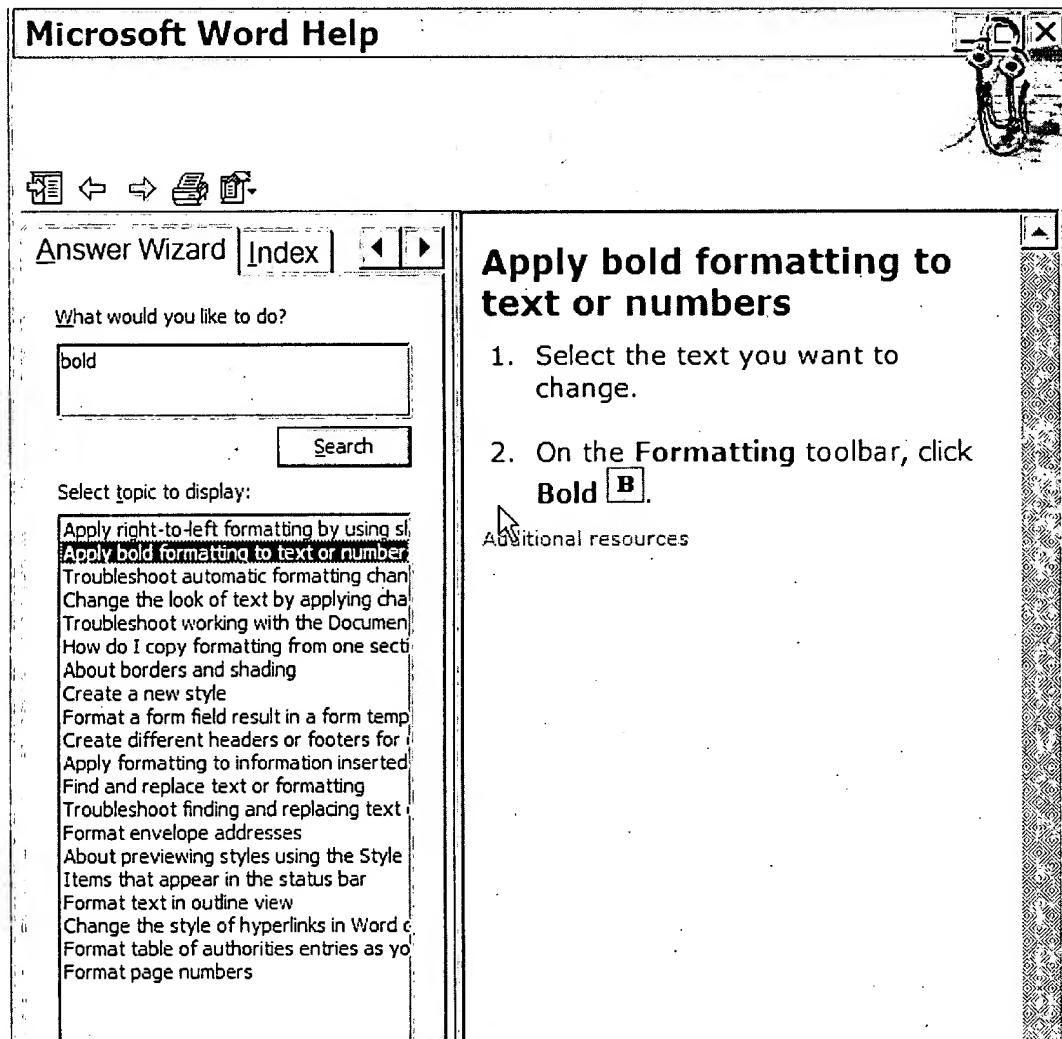


Figure 7

Shows interdependencies between icons, only one can be active at a time.

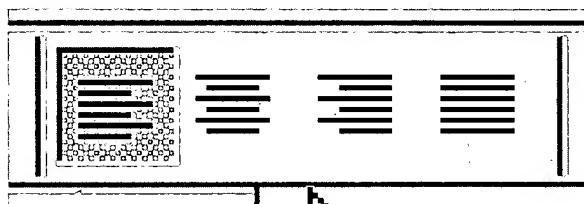


Figure 8

Shows interdependencies between icons, only one can be active at a time.

